

REMARKS

In the subject Office Action dated September 21, 2006, claims 1-20 were examined. In response thereto, claims 1, 4, 7-9, 13, 14, and 17-19 have been amended, claims 3, 5, 6, 10-12, 15, and 16 have been canceled, and claims 2 and 20 remain under active prosecution in the present application. Applicants respectfully assert that all amendments are supported by the original disclosure and do not introduce new matter. Moreover, Applicants further respectfully assert that the amendments merely clarify the scope of the claims.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "278" and "298" have both been used to designate the "biasing wheel" (see Figures 8 and 9). Applicants have changed numerals "298" to "278" in FIG. 8. In addition, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "670" has been used to designate both a "curved tooth segment" and an unidentified external handle portion (see Figure 29). Applicants have deleted the upper numeral 670" from FIG. 29. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are provided in reply to the Office action to avoid abandonment of the application.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 72, 176 and 500 (see Figures 4, 26 and 27). Applicants had amended paragraph [0046] to identify the slot 72 of FIG. 4, as supported in the cross-referenced applications incorporated by reference, and added numeral "174" to paragraph [0056] of the specification in compliance with 37 CFR 1.121(b). Corrected drawing sheets for FIGS. 26-27 amending numeral "500" to "10" are provided in compliance with 37 CFR 1.121(d) in reply to the Office action to avoid abandonment of the application.

The drawings were objected to because of the following minor informalities: The E-Beam disclosed on page 11, line 4 of the specification references number 82, but should be 80 as is consistent with the rest of the description and the drawings. Paragraph [0048] has been amended accordingly. In Figure 23, reference numeral "24" should be corrected to read "42" to maintain consistency with the specifications and drawings describing the "anti-backup release button." Also in Figure 23, reference numeral "433" should be corrected to read "432" to maintain consistency with

the specifications and drawings describing the "indicator pin." Drawing 23 has been amended accordingly. In Figure 22, reference numeral "432" is used twice, pointing to two separate parts. The rightward numeral "432" has been amended to "434" as used in paragraph [0085] and in compliance with 37 CFR 1.121(d).

Claim 16 was objected to because of the following informalities: It was suggested the claim should be correct to read "The surgical instrument of claim 15, wherein the indicator member comprises a gear having-a-at least one dwell area and gear section, the gear section engageable to the firing mechanism" Claim 13, which was amended to include the features of claim 16, has been amended in compliance with this suggestion.

Claim 13 was objected to because of the following informalities: It appears claim 3 was inadvertently copied and pasted onto the end of claim 13 (see Claim 13, Lines 14-16). The claim has been amended accordingly.

Claims 7-9, and 13-19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "the indicator gear" in line 3 of claim 7. Claim 1, that has been amended to recite the features of claim 6, has been amended to recite an indicator gear and the dependency of claim 7 has been amended to depend from claim 1 rather than claim 5 to obviate the rejection.

Claim 8 recites the limitation "said end effector" in line 1 of claim 8. Claim 9 recites the limitation "said end effector" in line 1 of claim 9. Claim 9 also recites the limitation "said shaft" in line 2 of claim 9. Claim 9 also recites the limitation "said firing member" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claims 8 and 9 have been amended to recite the implement portion comprising the end effector and shaft respectively.

Claim 13 recites the limitation "the indicator member" in lines 15-16 of claim 13, which was deemed to have insufficient antecedent basis for this limitation in the claim. The prior amendment has deleted this limitation, obviating the rejection.

Claim 14 recites the limitation "the knob" in line 2 of claim 14. The claim has been amended to obviate the insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the indicator member" in line 1 of claim 15. Claim 13, which has been amended to include the features of claim 15, has been amended to obviate the insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the indicator member" in line 1 of claim 16. Claim 13, which has been amended to include the features of claim 16, has been amended to obviate the insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the indicator gear" in line 3 of claim 17. The claim has been amended to obviate the insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "said end effector" in line 1 of claim 18. The claim has been amended to obviate the insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "said end effector" in line 1 of claim 19. Claim 19 also recites the limitation "said shaft" in line 2 of claim 19. The claim has been amended to obviate the insufficient antecedent basis for this limitation in the claim.

Turning to the substantive rejection in the subject Office action, claims 1-5, 8 and 9 were rejected under 35 U.S.C. 102(b) as being anticipated by Milliman et al. (5,865,361). Claims 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Milliman et al. (5,865,361). Claims 13-15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Milliman et al. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milliman et al (5,865,361) in view of Johnson et al. (6,010,054). Applicants appreciate the indication that claims 6, 7, 16, and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in the subject Office action and to include all of the limitations of the base claim and any intervening claims.

Applicants have amended claim 1 to recite the allowable subject matter of claim 6, thus rendering claim 1, as well as claims 2, 4 and 7-9 that depend therefrom, in condition for allowance.

Applicants have amended claim 13 to recite the allowable subject matter of claim 16, thus rendering claim 13, as well as claims 14, 17 and 18-20 that depend therefrom, in condition for allowance.

Conclusion

In light of the amendments and remarks made herein, it is respectfully submitted that the claims currently pending in the present application are in form for allowance. Accordingly, reconsideration of those claims, as amended herein, is earnestly solicited. Applicants encourage the Examiner to contact their representative, David Franklin at (513) 651-6856 or dfranklin@fbtlaw.com.

Since after amendment the claims total 12 with 2 independent, no fees are due, however, the Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

CERTIFICATE OF MAILING

I hereby certify that a copy of this correspondence is being deposited with the US Patent Office by electronic transmission, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 21, 2006.

Elizabeth A. Middleton
Elizabeth A. Middleton

Respectfully submitted,
Jeffrey S. Swayze et al.

David E. Franklin

David E. Franklin, Registration No. 39,194
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202-4182
Telephone (513) 651-6856